

**REMARKS**

The applicants respectfully request reconsideration in view of the amendment and the following remarks. Support for newly added claim 36 can be found in claims 16, 17 and 18. Support for newly added claims 37 and 38 can be found in the specification at page 5, lines 5-9. **A fee of \$54.00 is enclosed for the three extra total claims over twenty.**

Claims 16, 18, 19, 22-24 and 26-31 were rejected under 35 U.S.C. § 102(b) as being anticipated by Jankower *et al.* EP 0 351 943 ("Jankower"). Claims 16, 17, 19-22, 27, 28, 31 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lo *et al.* U.S. Patent No. 6,358,520 ("Lo") in view of Hasslin U.S. Patent No. 5,674,514 ("Hasslin"). Claims 16-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jankower in view of Epple *et al.* US 5,376,725 ("Eppel"). The applicants respectfully traverse these rejections.

**REPLY TO INTERVIEW**

On December 22, 2003, the applicants conducted a telephone interview with the Examiner. All the claims and prior art applied against the claims were discussed. An agreement was not reached. There were no exhibits shown. The applicants proposed to add an additional claim that incorporated the features of claims 16, 17 and 18 (see newly added claim 36. The Examiner indicated that the 102(b) rejection would be withdrawn with respect to the new claim. The applicants discussed that the applicants did not believe that Jankower anticipated the claimed invention because it did not disclose nor teach that the microparticle comprises a thermoplastic cycloolefin copolymer as is

claimed by the applicants' claimed invention. The Examiner still believed that rejection was proper. The applicants discussed supplying case law to support their position. The applicants discussed that the Examiner has not rejected claim 18 over the combination of Lo in view of Hasslin.

The applicants discussed that Hasslin does not give a hint to modify the embodiment of Lo in the sense of the present invention in order to render the advantageous microparticle of the present invention. Hasslin discloses many different types of polymers including cycloolefin polymers (col. 3, line 35), but this disclosure is in a laundry list of polymers that extends from col. 3, line 30 through col. 5, line 64. This list includes a group of twenty-two broad groups. It is noted that none of the specific examples of commercially available polymers disclosed at col. 5, lines 51-64 include a cycloolefin copolymer, although there were commercially available cycloolefins at the time of Hasslin. The Examiner said she would consider these arguments upon receiving the amendment.

The applicants also discussed that Epple relates to a cycloolefin copolymer useful in extrusion or injection molding (see col. 1, lines 53-65). There is no disclosure in Epple for controlled active substance release. The applicants discussed that Epple is not related to the applicants' claimed invention or combinable with Jankower.

#### **Section 102 Rejection**

Claims 16, 18, 19, 22-24, 26-31, 34 and 35 were rejected under 35 U.S.C. § 102(b) as being anticipated by Jankower. The applicants' claimed invention requires a thermoplastic cycloolefin copolymer. Jankower does not disclose nor teach that the microparticle comprises a thermoplastic cycloolefin copolymer as is claimed by the

applicants' claimed invention. For an anticipation rejection, Jankower must disclose the thermoplastic cycloolefin copolymer or disclose that the thermoplastic cycloolefin copolymer is inherent.

At page 5 of the response in the second full paragraph, the Examiner agrees that **Jankower does not specifically teach that the cycloolefin is thermoplastic**, but the Examiner asserts that the cycloolefin is generic, and it permits the use of thermoplastic cycloolefin. This is not the test for anticipation. First, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). There is no dispute that Jankower does not expressly describe a thermoplastic cycloolefin.

The Examiner is asserting that the cycloolefin would include thermoplastic. This is not the issue. Rather, the issue is whether the broad disclosure of Jankower either expressly or inherently describes a **specific subgenus**, i.e., a thermoplastic cycloolefin is used. As discussed above, the Examiner recognizes that Jankower does not expressly describe a thermoplastic cycloolefin. Moreover, the Examiner has failed to establish that Jankower discloses a composition which inherently uses a thermoplastic cycloolefin. See *Atlas Powder v. IRECO Inc.*, 190 F3d 1342, 1347, 51 USPQ2d 1943, 1946 (Fed. Cir. 1999) (under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates).

There is nothing in the disclosure that would have directed one of ordinary skill in the art to use a thermoplastic cycloolefin as is required by the applicants' claimed invention.

Again, the only example does not use a thermoplastic cycloolefin nor is there any teaching to use a thermoplastic cycloolefin as is claimed by the applicants. For the above reasons, this rejection should be withdrawn.

### **103 Rejections**

Claims 16-22, 27, 28, 31 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lo in view of Hasslin. Claims 16-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jankower in view of Epple. The applicants believe that Lo is the closest prior art.

Lo discloses a matrix comprising a water-insoluble pesticide microencapsulated in a shell and further comprising water-soluble polymers such as acrylic acid polymers. However, the present invention preferably relates to a microparticle wherein the active substance is not microencapsulated in a shell, but is preferably embedded into the polymer matrix (see the specification at page 2, 1st paragraph and claim 18). It is recognized that the Examiner has not rejected claim 18 over the combination of Lo in view of Hasslin. It is also recognized that claim 16 is not limited to an active substance that has been embedded in a matrix

Moreover the microparticle of the present invention comprises a water insoluble polymer, namely a thermoplastic cycloolefin-copolymer. Such microparticle provides all the advantages as set forth at pages 2 and 3 of the applicants' specification. As the Examiner has correctly recognized, Lo does not disclose the use of a thermoplastic cycloolefin copolymer as is required by the applicants' claimed invention. Lo describes the polymers at col. 3, lines 45-54 and states,

"The **water soluble polymers usable in this invention** include both synthetic and natural polymers such as polyvinylpyrrolidone,

polyvinyl alcohol, polyethylene oxides, ethylene/maleic anhydride copolymer, methyl vinyl ether-maleic anhydride copolymer, water-soluble cellulose, water-soluble polyamides or polyesters, copolymers or homopolymers of acrylic acids, water-soluble starches and modified starches, natural gums such as alginates, dextrans and proteins such as gelatins and caseins.” (emphasis added)

Lo requires that the polymer is a water-soluble polymer and **NOT** a water-insoluble polymer. Again, the microparticle of the present invention comprises a water insoluble polymer, namely a thermoplastic cycloolefin-copolymer. Therefore, Lo teaches away from the applicants’ claimed invention. Accordingly, this is why there is no suggestion in Lo’s list to use a thermoplastic cycloolefin copolymer.

Hasslin does not give a hint to modify the embodiment of Lo in the sense of the present invention in order to render the advantageous microparticle of the present invention. Hasslin discloses many different types of polymers including cycloolefin polymers (col. 3, line 35), but this disclosure is in a laundry list of polymers that extends from col. 3, line 30 through col. 5, line 64. This list includes a group of twenty-two broad groups. It is noted that none of the specific examples of commercially available polymers disclosed at col. 5, lines 51-64 include a cycloolefin copolymer, although there were commercially available cycloolefins at the time of Hasslin. There would be no reason for a person of ordinary skill in the art to select a cycloolefin copolymer from the multitude of polymers listed. Moreover, there is no reason to select a water-insoluble polymer from Hasslin, when Lo requires that the polymer is water soluble and to make the desired substitution as suggested by the Examiner. Furthermore, Hasslin does not even disclose the particular advantages of the cycloolefin copolymers compared to the

other polymers. Moreover Hasslin does not suggest that the cycloolefin behave any better than the other polymers.

### **Rejection Over Jankower In View Of Epple**

The present invention relates to a microparticle providing all the advantages set forth at pages 2 and 3 of the instant specification. There is no hint in Epple to modify the embodiment of Jankower in the sense of the present invention in order to render the advantageous microparticle of the present invention. Epple relates to a cycloolefin copolymer **useful in extrusion or injection molding** (see col. 1, lines 53-65). There is no disclosure in Epple for controlled active substance release. **Epple is not related to the applicants' claimed invention or combinable with Jankower.**

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters **without any direction** as to the particular one selection of the reference **without proper motivation**. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** is suggested by the prior art (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention;

the references themselves must provide some teaching whereby the applicant's combination would have been obvious); *In re Dow Chemical Co.*, 837 F.2d 469,473,5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (*In re Geiger*, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Lo in view of Hasslin and Jankower in view of Epple. For the above reasons, these rejections should be withdrawn.

A two month extension fee has been paid. If there are any additional fees due in connection with the filing of this response, including any fees required for an additional extension of time under 37 CFR 1.136, such an extension is requested and the Commissioner is authorized to charge or credit any overpayment to Deposit Account No. 03-2775.

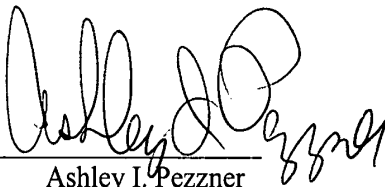
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For the reasons set forth above, Applicants believe that the claims are patentable over the references cited and applied by the Examiner and a prompt and favorable action is solicited. The applicants believe that these claims are in condition for allowance, however, if the Examiner disagrees, the applicants respectfully request that the Examiner telephone the undersigned at (302) 888-6270.

Respectfully submitted,

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